



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,010	11/29/2000	Paula Sundstrom	23878.0005	8550

7590

06/25/2002

Don J. Peltó
McKenna & Cuneo, LLP
1900 K Street, NW
Washington, DC 20006-1108

EXAMINER

ZARA, JANE J

ART UNIT	PAPER NUMBER
----------	--------------

1635

DATE MAILED: 06/25/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,010

Applicant(s)

SUNDSTROM, PAULA

Examiner

Jane Zara

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1635

DETAILED ACTION

Claims 1-43 are pending in the instant application.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 9, 15-21, 27-32, drawn to methods for interfering with expression of hyphal-specific genes in a fungus comprising manipulating environmental factors, classified in class 435, subclass 6.
- II. Claims 1-6, 10, 18-21, 27-33, drawn to methods for interfering with expression of hyphal-specific genes in a fungus comprising manipulating signal transduction pathways, classified in class 435, subclass 6.
- III. Claims 1-7, 11, 18-21, 27-32, drawn to methods for interfering with expression of hyphal-specific genes in a fungus comprising manipulating the binding of DNA BP to cis regulatory elements, classified in class 435, subclass 6.
- IV. Claims 1-7, 12, 18-21, 27-32, drawn to methods for interfering with expression of hyphal-specific genes in a fungus comprising manipulating the expression of DNA BP, classified in class 536, subclass 24.5.
- V. Claims 1-8, 13, 18-21, 27-32, drawn to methods for interfering with expression of hyphal-specific genes in a fungus comprising manipulating the binding of DNA BP to cis regulatory proteins, classified in class 435, subclass 6.

Art Unit: 1635

- VI. Claims 1-8, 14, 18-21, 27-32, drawn to methods for interfering with expression of hyphal-specific genes in a fungus comprising interfering with the expression of regulatory proteins of DNA BP, classified in class 536, subclass 24.5.
- VII. Claims 1, 18-27, drawn to methods for interfering with expression of hyphal-specific genes in a fungus comprising inhibiting cell growth of a fungus in a patient, classified in class 514, subclass 44.
- VIII. Claims 1, 34, drawn to methods for interfering with expression of hyphal-specific genes in a fungus comprising the inhibition of genes essential for the adhesion of a fungus to a patient, classified in class 514, subclass 44.
- IX. Claims 35-41, drawn to methods for characterizing genes under control of DNA BP in fungus, classified in class 435, subclass 6.
- X. Claims 42, 43, drawn to nucleic acid sequences, classified in class 536, subclass 23.1.

Applicants should note that claims 1-8, 18-21, 27-32 were found to be generic to the patentably distinct Groups listed and such claims will be examined according to the limitations of the elected Group. Applicants must indicate which hyphal-specific gene listed in claims 18-19 is to be included in the elected Group. Applicants must also indicate which cis regulatory element, DNA BP or binding domain listed in claims 28-32 are to be included in the elected Group.

Art Unit: 1635

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II and III and IV and V and VI and VII and VIII and IX are unrelated.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions comprise different and distinct methods whose steps are not required for or present in the methods of the other Groups. Furthermore, the end result of each Group's methods are different: Manipulation of environmental factors (Group I), manipulation of signal transduction pathways (Group II), manipulation of DNA BP binding to cis regulatory elements (Group III), manipulation of the expression of DNA BP (Group IV), manipulation of DNA BP binding to cis regulatory proteins (Group V), interfering with the expression of regulatory proteins of DNA BP (Group VI), inhibition of the fungal growth in a patient (Group VII), inhibition of genes essential for fungal adhesion to a patient (Group VIII) and characterizing genes under control of DNA BP in fungus (Group IX). Thus, the operation, function and effects of these Groups are different and distinct from each other.

Inventions I, II, III, IV, V, VI, VII, VIII, IX and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions Groups I-IX and Group X are biologically and functionally different and distinct from each other and thus one does not render the other

Art Unit: 1635

obvious. The nucleic acids of Group X are not used in the methods of Groups I-IX. The operation, function and effects of the compounds in Group X are completely different and distinct from the operation, function and effects of the methods of Groups I-IX, which comprise different and distinct methods to interfere with the expression of hyphal-specific genes in a fungus (Groups I-VIII), or a method of characterizing genes under control of DNA BP in a fungus (Group IX). Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be

Art Unit: 1635

retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is (703) 306-5820. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (703) 308-0447. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (703) 305-3413. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

JZ

June 21, 2002

JZ
TC1600